

### **REMARKS**

Applicant thanks the Examiner for withdrawing the drawing, claim and specification objections, and the enablement rejection, of record in the March 7, 2005 *Office Action*.

#### **Status of the Application**

Claims 1-4, 6-20, 22-27 and 29-33 are all the claims pending in the Application, as claim 28, and non-elected claims 33-48, are hereby cancelled. Claims 1-4, 6-20 and 22-32 stand rejected. Claims 29-33 are rewritten in independent form.

#### **35 U.S.C. § 101 Rejection**

The Examiner has again rejected claims 11 and 12 under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. Specifically, the Examiner alleges that “Applicant claims “means for communicating” by an electric wave,” and “[n]on-statutory subject matter includes means for communicating by an electric wave” (*O.A.*, p. 3).

Applicant has previously argued that claims 11 and 12 are not claiming an “electric wave” per se (which Applicant concedes could run afoul of the PTO’s *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*). Rather, claims 11 and 12, recite (*inter alia*) a “communicating means for communicating by an electric wave.” Thus, it is the “communicating means” that is claimed, not the specific “electric wave.” The “electric wave” is simply the medium that the “communicating means” communicates by. An illustrative, non-limiting, example of such an “electric wave” is a radio signal.

In response, the Examiner alleges that:

Applicant's amendments do not overcome the Interim Guidelines for Examination of Patent Applications for Patent Subject [sic-Matter] Eligibility, Annex IV, which is the current Office policy on statutory subject matter dealing with computer-based inventions. Communicating means for communicating by an electric wave is not statutory subject matter according to the four categories of invention defined in 35 U.S.C. 101.

Applicants again submit that the Examiner's position is incorrect.

**First**, despite the Examiner's allegation, Annex IV never indicates that a "means for communicating by an electric wave" is not statutory. Annex IV only indicates that an "electric wave" itself might not be statutory (at least that is the PTO's current position).

However, as explained above, claims 11 and 12 are not focused on an "electric wave," but are instead focused on a "communicating means." This "communicating means" is surely statutory under 35 U.S.C. § 101 as it can be described as a "machine" (since a means necessarily has some related structure for performing the recited function - *i.e.*, "communicating by an electric wave"). It is unclear to the Applicant why the Examiner does not believe that a "communicating means" is not a "process, machine, manufacture, or composition of matter."

**Second**, the Examiner's position is logically incorrect. A dependent claim cannot be non-statutory when it depends from claim that is statutory (since the dependent claim includes all of the features of the independent claim).

In view of all of the above, withdrawal of the rejection is respectfully requested.

**Anticipation and Obviousness Rejections**

The Examiner has rejected: (1) claims 1-4, 6, 11-20 and 22 under 35 U.S.C. § 102(a) as being anticipated by *Ueda* (US 5,973,680; hereinafter "*Ueda*"); (2) claims 7-10 under 35

U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Barton et al.* (US 6,233,389); hereinafter “*Barton*”); and (3) claims 23-32 under 35 U.S.C. § 103(a) as being unpatentable over *Ueda* in view of *Swix et al.* (US 6,609,253). These rejections are respectfully traversed.

*Independent Claims 1 and 17*

Applicant respectfully submits that *Ueda* fails to teach or suggest: (1) “storing each of a plurality of partial information of a plurality of delivery information beforehand;” and (2) that “the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and playback device, is renewed when necessary,” as recited in independent claims 1 and 17.

Specifically (as discussed in the June 6, 2005 *Amendment*), while *Ueda*’s terminal 101 obtains motion picture codes from server 121 and stores the code in memory 105, there is no teaching or suggestion therein that these codes are ever “renewed.” Rather, *Ueda* only discloses the simple storage and re-use of motion picture codes (after a search of these codes) when the desired video is again selected (col. 9, lines 47-57). Thus, Applicants respectfully submit that these codes can only reasonably be read as being stored once, and are never “renewed.”

In response (see pages 2 and 3 of the instant *Office Action*), the Examiner alleges that such a “renewing” is disclosed in *Ueda* in column 8, lines 62-64. However, this portion of *Ueda* only indicates that:

The terminal 101 sequentially receives the video data in the memory 105 such that the motion picture codes are continually reproduced.

Thus, this portion of *Ueda* only discloses that stored motion picture codes are reproduced for viewing, not that partial information, which a user chooses, is “renewed” in any way. Accordingly, Applicants respectfully submit that neither this portion, nor any other portion of *Ueda*, support the Examiner’s rejection of independent claims 1 and 17.

The Examiner disagrees, and alleges that:

[t]he renewing of data in Applicant’s invention is receiving more information after the information in the buffer of the invention has been played for the user. This is what Ueda did in column 8, lines 62-64. Ueda received additional information to continue playback of the video.

Examiner is misunderstanding - renewal of data is, for example, the renewal is of the partial information from which the - renewal is replacement.

Not the renewal claimed. Buffer not even disclosed in application. In fact, buffer is not even discussed in the instant Application.

Renewal of partial information, - see pages 26 and 27 of the specification.

Partial information can only reasonably be read as menu items (see col. 8, lines 30-50), while the remaining information can only reasonably be read as the selected video (see col. 8, lines 50-54). The portion cited by the Examiner (col. 8, lines 62-64) describes the operation of the playback of the selected video, which is only equivalent to the remaining information. This has no relation to the menu system.

Independent Claims 2 and 18

Applicant again respectfully submits that *Ueda* fails to teach or suggest that: (1) “at least a portion of the plurality of partial information is stored in the means for storing prior to use of the information delivery system by a user,” as recited in independent claim 2; and (2) “at least a portion of the plurality of partial information is stored in the information storage and playback device prior to use of the information delivery system by a user,” as recited in independent claim 18.

Specifically, Applicant previously argued that there is no teaching or suggestion that any particular information is stored anywhere in *Ueda* prior to the use of its system by a user. Rather, as shown in FIG. 9 of *Ueda*, all of the menu screens and data in *Ueda* must first be requested by a user using the *Ueda* system.

The Examiner disagrees, and alleges that:

[a]s clearly shown in figure 12 of *Ueda*, the terminal memory or *means for storage* contained the picture codes. The invention could not function if the memory did not buffer the video prior to playback.

However, memory only buffers video after the video has been selected for playback by the user. Thus, there is no buffering prior to the use of the system by the user, as is recited in independent claims 2 and 18.

Independent Claim 29-32

Applicant respectfully submits that no combination of *Ueda* and *Swix* can reasonably be read as teaching or suggestion independent claim 29-32’s recitation of varying times of accounting of cost information based on: (1) times of reproduction of partial information (claim

29); (2) times of reproduction of remaining information (claim 30); (3) times of finishing of reproducing remaining information (claim 31); or (4) times of transmitting remaining information (claim 32).

Specifically, although the Examiner alleges that *Swix*'s pay-per-view system teaches or suggests the general tracking of cost information, Applicants submit that such a general disclosure cannot teach or suggest the specific times of cost tracking variously recited in independent claims 29-33.

In view of all of the above, Applicant respectfully submits that independent claims 1, 2, 17, 18 and 29-32 are patentable over the applied references.

Further, Applicant respectfully submits that rejected dependent claims 3, 4, 6-16, 19, 20, 22-27 are allowable, *at least* by virtue of their dependency, and that the secondary references (*Barton* and *Swix*) fails to teach or suggest the features missing from the independent claims, as discussed above.

#### Dependent Claims

Additionally, Applicant respectfully submits that rejected dependent claims 3, 4, 6-16, 19, 20 and 22-27 are separately patentable over the applied references.

For example, Applicant respectfully submits that *Ueda* fails to teach or suggest claim 6's recitation that "the partial information of the delivery information, which is transmitted from the information delivery device to the information storage and playback device through the information communicating means and is received and stored in the information storage and

playback device, is renewed when necessary,” for at least the reasons discussed above with respect to independent claims 1 and 17.

Further, Applicant respectfully submits that no combination of *Ueda* or *Barton* teaches or suggests claim 7, 8, 9 and 10’s recitation that “the information storage and playback device, which includes a plurality of storage mediums for storing information, stores the partial information of the delivery information in a primary storage medium, and stores the partial information of the delivery information and remaining information of the delivery information transmitted from the information delivery device in one of the other storage mediums different from the primary storage medium.” Specifically, while different storage mediums are disclosed in *Barton*, *Barton* fails to teach or suggest that different parts of a single file are stored in two different storage mediums.

Applicant notes that the Examiner has not responded to the arguments with respect to claims 7-10. Thus, it is unclear why the Examiner has maintained this rejection.

Further, Applicant respectfully submits that no combination of *Ueda* or *Swix* teaches or suggests claim 23’s recitation of “an information provider, who delivers the image, reflection or voice information to the information user by employing the information delivery device, accounts for use of the image, reflection or voice information by the information user, the accounting including cost information attributable to the information user,” for at least the reasons discussed above with respect to independent claim 28.

Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

**Conclusion**

In view of the foregoing, it is respectfully submitted that claims 1-4, 6-20, 22-27 and 29-33 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-4, 6-20, 22-27 and 29-33.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,

/Howard L. Bernstein Reg. No. 25,665/  
Howard L. Bernstein  
Registration No. 25,665

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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